



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/555,951

09/05/2000

Lester Andrew Evans

RJENK14.001A

8225

20995

7590

02/24/2005

KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/555,951

Applicant(s)

EVANS ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-37 and 42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) 32-34 is/are allowed.  
6) ☐ Claim(s) 23-31, 35-37 and 42 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim(s) Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim(s)s 23-27, 35 and 42** are rejected under 35 U.S.C. 102(e) as being anticipated by Venturini (US 5,987,317).

Regarding **claim(s) 23**, Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 “messages”) to a caller (column 4, line 51 “users”) in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 “PBX responds”) directed to a directory number used commonly by different subscribers to access their mailboxes, wherein the answerphone service is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network via international telecommunications links, the method (column 1, lines 6-8), comprising:

providing an identification code (column 8, line 29 “the access code”) identifying a mailbox (column 8, line 34 “mailbox”) associated with a subscriber (column 8, line 46 “user”) through an answerphone service (column 8, lines 29-48) [The mobile terminal 10

user dials the access code with a request to retrieve the voice messages from the voice mailbox]; and

entering a first mode of answerphone operation for a call originating from within the first network (column 8, line 52 “for a case the message is transmitted to the public network”) and a second, different mode of answerphone operation for a call originating from within the second network, wherein the answerphone service enters either the first or the second mode of operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the first mode, since the limitation is either first mode or international mode].

Regarding **claim(s) 24**, Venturini discloses in the first mode of operation, if the call is not diverted, providing a message retrieval service, and if the call is diverted, providing a message deposit service (column 7, lines 12-23).

Regarding **claim(s) 25**, Venturini discloses determining whether the call is diverted using information received during call establishment (column 7, lines 24-35).

Regarding **claim(s) 26**, Venturini discloses providing in the second mode of operation either a message deposit service or a message retrieve service in

Art Unit: 2645

dependence of a receipt of a selection indicator from the caller during the call (column 7, lines 36-41).

Regarding **claim(s) 27**, Venturini discloses in the second mode prompting the caller, after inputting the identification code during the call, for a voice message to be received and stored, and providing the message retrieve service if the indicator is received from the user (column 8, lines 29-48).

Regarding **claim(s) 35**, Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 "messages") to a caller (column 4, line 51 "users") in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 "PBX responds) directed to a directory number used commonly by different subscribers to access their mailboxes, wherein the answerphone service is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network via international links, wherein the answerphone service is configured to enter a first mode of answerphone operation for a call originating from within the first network and a second, different mode of answerphone operation for a call originating from within the second network, the method (column 1, lines 6-8), comprising:

identifying, through an answerphone service (column 8, line 30 "the network"), a mailbox (column 8, line 34 "mailbox") associated with a subscriber identification code

Art Unit: 2645

(column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox]; and

entering either the first mode or the second mode of answerphone operation (column 8, line 52 “for a case the message is transmitted to the public network”) in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the first mode, since the limitation is either first mode or second mode].

Regarding **claim(s) 42**, Venturini discloses a voice processing system for a mobile communications system, wherein the voice processing system is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network by international telecommunications links, wherein the voice processing system is configured to enter a first mode of answerphone operation for a call originating from within the first network and a second, different mode of answerphone operation in response to a call originating from within the second network, wherein the voice processing system is (column 1, lines 6-8) adapted to identify a mailbox (column 8, line 34 “mailbox”) associated with a subscriber (column 8, line 46 “user”) by way of an identification code (column 8, line 29 “the access code”) processed through an answerphone service (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice

messages from the voice mailbox], and to enter either the first mode of answerphone operation (column 8, line 52 "for a case the message is transmitted to the public network") or the second, different, mode of answerphone operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the first mode, since the limitation is either first mode or second mode].

***Claim(s) Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claim(s) under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claim(s) was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim(s) that was not commonly owned at the time a later invention was made in order for the

Art Unit: 2645

examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim(s) 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Hulen et al. (US 5,497,373).

Regarding **claim(s) 28**, Venturini as applied to **claim(s) 26** differs from **claim(s) 28**, in that it fails to disclose the indicator comprises a DTMF tone.

However, Hulen teaches the indicator comprises a DTMF tone (column 7, lines 37-40).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the indicator comprises a DTMF tone of Hulen in the invention of Venturini.

The modification of the invention would offer the capability of the indicator comprises a DTMF tone such as the equipment user would define their own service application.

6. **Claim(s)s 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Kennedy, III et al. (US 5,539,810).

Regarding **claim(s) 29**, Venturini as applied to **claim(s) 23** above differs from **claim(s) 29** in that it fails to disclose prompting the caller for the identification code.



However, Kennedy teaches prompting the caller for the identification code if the identification code is otherwise not associated with the call when received (column 11, lines 33-38).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use prompting the caller for the identification code of Kennedy in the invention of Venturini.

Doing so would request an identification code.

Regarding **claim(s) 30**, Kennedy teaches wherein the identification code corresponds to a directory number of the subscriber (column 11, lines 17-19).

7. **Claim(s)s 31, 36 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Wilson et al. (US 5,838,772).

Regarding **claim(s) 31** Venturini as applied to claim(s) 23 differs from claim(s) 31 in that it fails to disclose identifying a call of international origin through an international origin indicator in signaling associated with the call.

However, Wilson teaches identifying a call of international origin through an international origin indicator in signaling associated with the call (column 7, lines 44-51).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Venturini use prompting the caller for the identification code as taught by Kennedy.

Art Unit: 2645

Doing so the system would request an identification code so that the user would access its mailbox.

Regarding **claim(s) 36**, Wilson teaches deriving the origin of the call using information received during call establishment (column 8, lines 31-38).

Regarding **claim(s) 37**, Wilson teaches using the common directory number by all subscribers to access the answerphone service (column 7, lines 44-46).

***Allowable Subject Matter***

8. **Claim(s) 32-34** are allowable

9. The following is a statement of reasons for the indication of allowable subject matter.

Regarding **claim(s) 32**, the prior art of record at this time fails to disclose setting the divert flag if the call is diverted from a mobile station to the apparatus and the mobile station is located within a coverage area of the mobile communications system, associating the CLI signal with the call if the call originates or is diverted from a mobile station within the coverage area and the mobile station is preset to transmit the CLI signal and associating the international origin indicator with the call if the call originates or is diverted from a mobile station and the mobile station is used at a location causing

Art Unit: 2645

the international origin indicator to be sent to the mobile communications system during call establishment.

***Response to Arguments***

10. Applicant's arguments filed 11/05/2004 have been fully considered but they are not persuasive.

The applicant stated on page 7, last paragraph that Venturini fails to disclose an answerphone service located in first network and responsive to calls originating from within a second network connected to the first network via international communications links.

The examiner respectfully disagrees.

**Claim(s) 23, 35 and 43** preambles describe the limitations that the applicant argues. The preamble limitation is the intended use and the body of the claim(s) give the alternative either or. Therefore the examiner chooses one of the alternative to meet the limitations of the claim(s).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**GERALD GAUTHIER**  
**PATENT EXAMINER**

g.g.  
February 10, 2005



**FAN TSANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**